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| 10/032,459 | 01/02/2002 | Raymond Anthony Joao | RJ460 | 6603 |

7590 08/23/2007
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| EXAMINER |
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RETTA, YEHDEGA

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| ART UNIT | PAPER NUMBER |
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3622

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08/23/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/032,459

Applicant(s)

JOAO, RAYMOND ANTHONY

Examiner

Yehdega Retta

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 snf 21-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response amendment filed June 1, 2007. Applicant amended claims 1-10 and added new claims 21-30. Claims 1-10 and 21-30 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 10, 27 and 28-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites a processor detecting at least one of a:

telemarketing call being made to an individual;

telemarketing call being answered;

a telemarketing call message being provided to an individual;

The processor records information regarding:

Telemarketing call information or telemarketing call message information provided to the individual and information obtained from the individual in response to the telemarketing call or the telemarketing call message.

The processor calculating compensation or reward for the individual for at least one of receiving, listening to and participation in the telemarketing call or the telemarketing call message.

The claim recites the processor detecting telemarketing call being answered and the processor records information obtained from the individual, the processor however calculates reward or compensation just for receiving or listening or participating in the marketing call or the telemarketing call message. Since the claim recites that the individual is rewarded for receiving or listening or participating in the marketing call or call message, it is understood that the individual is reward whether he/she provides information or not or whether information is obtained from the individual.

Claims 1, 3, 7-10 and 27-28 also recites a marketing call and a marketing call message. Applicant's specification teaches "(t)he apparatus and method of the present invention can provide compensation to individuals or entities who or which consent to receive, listen to, and/or participate in, telemarketing calls, telemarketing-related surveys, and/or marketing campaigns, advertising campaigns, promotional campaigns, and/or surveys and/or polls, which are conducted via telephone, telecommunications, and/or other means". Or "(i)t is another object of the present invention to provide an apparatus and method for providing compensation-based telemarketing information which provides compensation or rewards to individuals or entities who or which consent to receive, listen to, and/or participate in, telemarketing calls, telemarketing messages, telemarketing-related surveys, and/or marketing campaigns, advertising campaigns, promotional campaigns, and/or surveys and/or polls". The specification teaches a *telemarketing calls or telemarketing messages*. It is unclear if applicant intended to claim a "telemarketing message". Clarification is required.

Claims 27 and 28 recites wherein the processor identifies the individual to whom the telemarketing call is made or for whom the telemarketing call message is left, wherein the

processor identifies a target audience of individuals to whom the telemarketing call is made or for whom the telemarketing call message is left. Claim 1 however claims the processor detecting at least one of a telemarketing call being made to an individual a telemarketing call being answered and a telemarketing “call” message being provided. Since claim 1 includes alternative limitation the prior art does not have to teach all the limitations.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 24-28 and 30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Luth et al. (US 6,446,044).

Regarding claims 1-9, Luth teaches a processor (see col. 6 line 48 to col. 7 line 4) for detecting a survey being performed; a memory for storing survey information, user information and an output for outputting information regarding compensation or reward; wherein the reward is earned is at least cash, non-cash, etc., output device for transmitting the reward information to a communication device associated with the individual(see abstract, fig. 1 and col. 1 lines 23-46, col. 3 lines 1-36); receiver for receiving information regarding the survey or poll (computer or telephone).

Regarding claims 24-26 and 30, Luth teaches that the system being implemented over the Internet, telephone or mailed (see col. 6 lines 46-67). Personal digital assistance, a wireless telephone and a personal computer are part of the Internet and telephone service therefore are anticipated by Luth.

Regarding claims 27 and 28 Luth teaches wherein the processor identifies the individual to whom the telemarketing call is made or for whom the telemarketing "call" message is left, wherein the processor identifies a target audience of individuals to whom the telemarketing call is made or for whom the telemarketing call message is left (see col. 3 lines 1-37).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 21-23 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luth et al. (US 6,446,044) and official notice.

Regarding claims 10 and 29, Luth does not teaches wherein the at least one of a telemarketing call or the telemarketing call message contains a combination of live information and pre-recorded information or a video information. However official notice is taken that is old and well known in the art of telemarketing for the telemarketing message to include a live information and pre-recorded information or video information. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include different types of message or information in Luth's telemarketing system based on the desire of the telemarketer.

Regarding claims 21-23, Luth teaches an extremely effective and efficient surveying system that can result in a very detailed and extensive data base of members who are willing to complete surveys in exchange for rewards, for example, cash (see col. 2 lines 41-43). Luth however failed to explicitly indicate other types of reward. Official notice is taken that is old and well known in the art of marketing to provide incentive in the form of cash or non-cash such as coupon, rebate, product or service. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to know that the system of Luth would provide other types of reward, if the telemarketer wants to provide different kinds of reward that is more profitable.

Response to Arguments

Applicant's arguments filed June 1, 2007 have been fully considered but they are not persuasive. Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

Applicant asserts that the prior art does not teach every limitation in the claims. Contrary to applicant's assertion the limitations as recited in the claims are either taught by Luth or are obvious over Luth, as indicated above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Yehdega Retta', is positioned above the printed name.

Yehdega Retta
Primary Examiner
Art Unit 3622